

ESTTA Tracking number: **ESTTA449936**

Filing date: **01/06/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	3D International, LLC
Granted to Date of previous extension	01/07/2012
Address	20724 Centre Pointe Parkway, Unit 1 Santa Clarita, CA 91350 UNITED STATES

Attorney information	Thomas W. Cook Thomas Cook Intellectual Property Attorneys P. O. Box 1989 Sausalito, CA 94966 UNITED STATES tom@thomascooklaw.com
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Applicant Information

Application No	85312684	Publication date	11/08/2011
Opposition Filing Date	01/06/2012	Opposition Period Ends	01/07/2012
Applicant	Palm Beach Motoring Accessories, Inc. 7744 S.W. Jack James Drive Stuart, FL 34997 UNITED STATES		

Goods/Services Affected by Opposition

Class 038. First Use: 2011/04/08 First Use In Commerce: 2011/04/08 All goods and services in the class are opposed, namely: Providing on-line forums for the exchange of messages among computer users concerning the cleaning, polishing and detailing of motor vehicles
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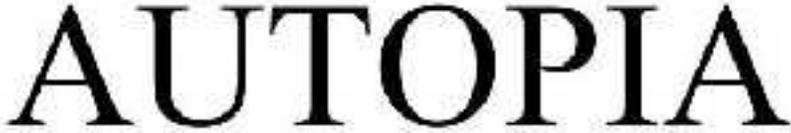
Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Marks Cited by Opposer as Basis for Opposition

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	AUTOPIA FORUMS		
Goods/Services	IC 035 - On-line advertising in the field of auto detailing; provider of		

	<p>advertising and marketing services promoting the goods and services of others on-line communities and web pages; providing an on-line searchable database featuring classified ad listings. IC 038 - Providing an on-line forum for auto detailing users and enthusiasts to discuss car care detailing supplies, auto care products, cleaning techniques, polishing techniques and equipment in the field of car care; posting of vehicle images, question posting and answers, exchange of ideas. IC 041 - Providing an on-line computer platform in the field of auto care and detailing topic discussion, namely; educational guidebooks and reference guides, post vehicle images, posting user articles, blogs and non-downloadable publications, complication and archiving of frequently asked questions, posting of knowledge based collaboration materials.</p>
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U.S. Application No.	85338384	Application Date	06/06/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	AUTOPIA		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 1999/10/17 First Use In Commerce: 1999/10/17 In the field of auto detailing; provider of advertising and marketing services promoting the goods and services of others on-line communities and web pages; providing an on-line searchable database featuring classified ad listings</p> <p>Class 038. First use: First Use: 1999/10/17 First Use In Commerce: 1999/10/17 Providing an on-line forum for auto detailing users and enthusiasts to discuss car care detailing supplies, auto care products, cleaning techniques, polishing techniques and equipment in the field of car care; posting of vehicle images, question posting and answers, exchange of ideas</p> <p>Class 041. First use: First Use: 1999/10/17 First Use In Commerce: 1999/10/17 Providing an on-line computer platform in the field of auto care and detailing topic discussion, namely; educational guidebooks and reference guides, post vehicle images, posting user articles, blogs and non-downloadable publications, complication and archiving of frequently asked questions, posting of knowledge based collaboration materials</p>		

Attachments	<p>85338384#TMSN.jpeg (1 page)(bytes) 2012 01 06 Notice of Opposition - AUTOPIAFORUMS-10.pdf (8 pages)(94421 bytes)</p>
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Thomas W. Cook/
Name	Thomas W. Cook
Date	01/06/2012

1 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
2 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

3 In the Matter of Trademark Application Serial No. 85/312,684

4 Mark: AUTOPIAFORUMS

5 _____)
6 3D PRODUCTS, LLC, a)
California limited liability company.)

7 Opposer,)

8 v.)

9 PALM BEACH MOTORING)
10 ACCESSORIES, INC.,)
a Florida corporation)

11 Applicant.)
12 _____)

Opposition No. _____

13 **NOTICE OF OPPOSITION**

14
15 Opposer, 3D PRODUCTS, LLC, is a California limited liability company, with
16 principal place of business at 20724 Centre Pointe Pkwy, Unit 1, Santa Clarita, California
17 91350.

18 Opposer believes that it will be damaged by registration of the mark shown in the
19 referenced application, and hereby opposes the same.

20 Description of the Applicant's Application:

21 Applicant: Palm Beach Motoring Accessories, Inc.
22 Serial No.: 85/312,684
23 Filed: May 4, 2011
24 Mark: AUTOPIAFORUMS
25 Published: November 8, 2011
26 Class: International class 38
27 Goods claimed: Providing on-line forums for the exchange of messages
among computer users concerning the cleaning,
28 App. Type: Use (1-A)
polishing and detailing of motor vehicles

1 As grounds for opposition, Opposer alleges as follows:

2 1. On or about October 17, 1999, Opposer, or its predecessor in interest, began to
3 provide, under the marks AUTOPIA and AUTOPIA FORUMS (hereinafter
4 “Opposer’s Marks”), the following services (hereinafter “Opposer’s Services”):

5
6 a. IC 035 - advertising and marketing services promoting the goods and services
7 of others on-line communities and web pages; providing an on-line searchable
8 database featuring classified ad listings.

9
10 b. IC 038 - on-line forum for auto detailing users and enthusiasts to discuss car
11 care detailing supplies, auto care products, cleaning techniques, polishing
12 techniques and equipment in the field of car care; posting of vehicle images,
13 question posting and answers, exchange of ideas.

14
15 c. IC 041 - on-line computer platform in the field of auto care and detailing topic
16 discussion, namely; educational guidebooks and reference guides, post vehicle
17 images, posting user articles, blogs and non-downloadable publications,
18 compilation and archiving of frequently asked questions, posting of
19 knowledge based collaboration materials.

20
21 2. Opposer’s Marks, when supplying Opposer’s Services, have been in valid and
22 continuous use since the date of first use and has not been abandoned. By use of
23 Opposer’s Marks, Opposer has created a public awareness of Opposer’s Marks as
24 trademarks identifying Opposer as the source of Opposer’s Services.

25
26 3. Opposer’s Marks are symbolic of extensive valuable goodwill built up by Opposer
27 through substantial amounts of effort, time, money, promotion, and advertising in
28 promoting Opposer’s Services under Opposer’s Marks.

1 4. Opposer's Marks have come to represent high quality on line distribution services,
2 and a high quality and well known forum for discussion of auto detailing and auto
3 care products. By reason of offering quality services, and rendering extensive sales
4 efforts and advertising expenditures under Opposer's Marks, Opposer has become
5 known throughout the auto detailing industry as the source of Opposer's Services.
6

7 5. Palm Beach Motoring Accessories, Inc. (hereinafter referred to as "Applicant") seeks
8 to register the mark AUTOPIAFORUMS (hereinafter "Applicant's Mark") for the
9 services it has identified in class 038, i.e. "Providing on-line forums for the exchange
10 of messages among computer users concerning the cleaning, polishing and detailing
11 of motor vehicles" (hereinafter "Opposer's Services").
12

13 6. Applicant has claimed it first used Applicant's Mark on April 8, 2011, about one
14 month prior to the date of filing of this application on March 8, 2011, as evidenced by
15 the publication of said mark in the Trademark Official Gazette.
16

17 7. On information and belief, some of Applicant's Services are provided using the same
18 channels of trade as Opposer uses as it provides Opposer's Services.
19

20 8. On information and belief, some of Applicant's services are marketed to the same
21 potential consumers as consumers of Opposer's Services.
22

23 9. Some of Applicant's Services are related to Opposer's Services.
24

25 10. Opposer's Marks and Applicant's Mark each contain the word "AUTOPIA."
26

27 11. The word "AUTOPIA" is highly distinctive, and creates a strong commercial
28 impression.

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12. Applicant's Mark, when Applicant's Mark is used on Applicant's Services as identified in this application, is confusingly similar to Opposer's Marks when Opposer's Marks are used on Opposer's Services.

13. Due to the similarity of Opposer's Marks and Applicant's Mark, and the related nature of Applicant's Services and Opposer's Services, Applicant's Mark so resembles Opposer's Marks so as to be likely to cause confusion, or to cause mistake, or to deceive.

14. If Applicant is permitted to use and register Applicant's Mark for Applicant's Services, confusion in the trade between Applicant's Mark and Opposer's Marks caused by similarity between Applicant's Mark and Opposer's Marks will result in damage and injury to Opposer.

15. If Applicant is granted a registration for Applicant's Mark, Applicant would obtain thereby at least a *prima facie* exclusive right to use "autopia" for all services identified in this application, and such registration and right will be a source of injury to Opposer.

16. On information and belief, Applicant was doing business under the name "Detail City" prior to about January of 2011.

17. On information and belief, Applicant was doing business under the name "Autogeek" prior to about January of 2011.

18. On information and belief, Applicant first began using the word "autopia" to identify itself, on April 8, 2011, as Applicant has declared in this application.

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- 19. On information and belief, Applicant first began using the word “autopia” on a web site only after March 8, 2011.
- 20. On information and belief, Applicant first began using the word “autopia” as a service mark only after March 8, 2011.
- 21. On information and belief, Applicant did not use the word “autopia” on a web site, or to identify itself, prior to January of 2011.
- 22. On information and belief, Applicant had not used the word “autopia” in the United States as of Applicant’s filing date of May 4, 2011.
- 23. On information and belief, no predecessor in title of Applicant used the word “autopia” in the United States as of Applicant’s filing date of May 4, 2011.
- 24. On information and belief, Applicant was doing business under the name “Detail City” prior to about March 8 of 2011.
- 25. On information and belief, Applicant was doing business under the name “Autogeek” prior to about March 8 of 2011.
- 26. On information and belief, Applicant was doing business only under the name “Detail City” prior to about March 8 of 2011.
- 27. On information and belief, Applicant was doing business only under the name “Autogeek” prior to about March 8 of 2011.

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- 1 28. On information and belief, Applicant first began using the word “autopia” to identify
2 itself, on or about March 8 of 2011.
3
- 4 29. On information and belief, Applicant advertised using Opposer’s web site while
5 Applicant was doing business under the name “Detail City.”
6
- 7 30. On information and belief, Applicant advertised using Opposer’s web site while
8 Applicant was doing business under the name “Autogeek.”
9
- 10 31. On information and belief, Applicant advertised using Opposer’s web site before
11 Applicant changed its name to a name containing the word “autopia.”
12
- 13 32. On information and belief, Applicant advertised using Opposer’s web site before
14 Applicant used the word “autopia” to refer to Applicant.
15
- 16 33. On information and belief, Applicant advertised using Opposer’s web site before
17 Applicant used the word “autopia” as a service mark.
18
- 19 34. On information and belief, Applicant advertised using Opposer’s web site while
20 Applicant was doing business under the name “Palm Beach Motoring Accessories.”
21
- 22 35. On information and belief, Applicant knew of Opposer’s web site and Opposer’s use
23 of Opposer’s Marks before it filed this application for registration of Applicant’s
24 Mark.
25
- 26 36. On information and belief, Opposer alleges Applicant has committed fraud in the
27 prosecution of this application by making one or more inaccurate statements. More
28 specifically, and in view of the similarity of Opposer’s Marks (AUTOPIA) and

1 Applicant's Mark (AUTOPIA FORUMS), and the nature of the "forum" services
2 supplied by Opposer and Applicant, and the knowledge of Applicant of Opposer's use
3 of Opposer's Marks prior to the filing of this application, Opposer alleges that
4 applicant wrongfully declared in this application as follows:

5 "no other person, firm, corporation, or association has the right to use said
6 mark in commerce either in the identical form thereof or in such near
7 resemblance thereto as to be likely, when used on or in connection with the
8 goods of such other person, to cause confusion, or to cause mistake, or to
9 deceive"

9 37. Opposer files herewith \$300.00 for the filing fee for this Notice of Opposition, as
10 required by 37 C.F.R. §2.6(a)(17).

11
12 WHEREFORE, Opposer prays that the registration of the mark set forth in
13 Application Serial No. 85/312,684 be denied and refused, and that this opposition be
14 sustained in favor of Opposer.

15 Opposer has appointed Thomas W. Cook, Esq., Patent and Trademark Office
16 Registration No. 38,849, a member of the Bar of the Supreme Court of California, with
17 offices at 3030 Bridgeway, Suite 425, Sausalito, California 94965, telephone number 415-
18 339-8550, as its attorney in the matter of this Opposition to transact all business in
19 connection therewith, and to receive all communications relating thereto.

20
21 Respectfully submitted,

22
23 

24 Date: January 5, 2012

25 Thomas W. Cook, 38,849
26 Attorney for Opposer
27 (415) 339-8550
28 P.O. Box 1989
3030 Bridgeway, Suite 425
Sausalito, California 94965
Attorney for Opposer
3D Products, LLC

1 CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)

2 I hereby certify that the attached NOTICE OF OPPOSITION is being filed
3 electronically, utilizing the Electronic System for Trademark Trials and Appeals, on January
4 6, 2012.



5
6 Thomas Cook

7 **CERTIFICATE OF SERVICE BY U.S. MAIL, 37 C.F.R. §2.119(a)**

8 I hereby declare:

9 I am over the age of 18 years, and am not a party to the within cause. I am employed
10 in Sausalito, California.

11 My business address is 3030 Bridgeway, Suite 425-430, Sausalito, California. My
12 mailing address is P.O. Box 1989, Sausalito, California.

13 On the date first written below, I served a true copy of the attached document
14 entitled:

15 **NOTICE OF OPPOSITION**

16 by placing it in a sealed envelope and depositing it in the United States mail, first class
17 postage fully prepaid, addressed to the following:

18 Palm Beach Motoring Accessories, Inc.
19 7744 S.W. Jack James Drive
20 Stuart, FLORIDA 34997

21 I declare under penalty of perjury that the foregoing is true and correct. Executed at
22 Sausalito, California on January 6, 2012



23 Thomas Cook

24 I further declare:

25 On the date first written below, I served a true "courtesy copy" of the attached
26 document entitled:

27 **NOTICE OF OPPOSITION**

28 by placing it in a sealed envelope and depositing it in the United States mail, first class
postage fully prepaid, addressed to the following:

Attorney of Record and Filing Correspondent:
LEO ZUCKER
LAW OFFICE OF LEO ZUCKER
PO BOX 1177, YORKTOWN HEIGHTS, NY 10598-8177

I declare under penalty of perjury that the foregoing is true and correct. Executed at
Sausalito, California on January 6, 2012



Thomas Cook